

REMARKS

This amendment and response is being submitted in response to the Office Action dated May 2, 2006, the time to respond being until August 2, 2006. Claims 1, 7, and 13 are herein amended. Claims 5 and 12 are herein canceled. Claim 8 is withdrawn from consideration. New claim 14 was added. The amendment raises no new issues and entry is respectfully requested. Claims 1-4, 6, 7, 9-11, 13, 14 remain pending. Allowance of this application is respectfully requested.

During a teleconference with the Examiner on April 21, 2006, pursuant to a restriction requirement, Applicant provisionally elected claims 1-7 and 9-13 without traverse. Applicant herein affirms election of claims 1-7 and 9-13 without traverse.

The Examiner objected to the drawings for failing to show every feature specified in the claims. Particularly, the Examiner asserts that the recessed lighting fixture of claim 7 must be shown or the feature(s) canceled from the claims. Applicant respectfully submits that the recessed lighting fixture is shown in dashed lines (because it is hidden from view) and referenced as numeral 21 in FIG. 2. Therefore, a Replacement Drawing is not submitted herewith nor is such matter canceled from claim 7.

The Examiner rejected claims 1, 7, and 13 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. Particularly, the Examiner contends that claims 1, 7, and 13 provides insufficient antecedent basis for “finishing ring”, “covering plate”, and/or “conventional trim ring”. Applicant has deleted the phrases “covering plate” and “conventional trim ring” from the claims for clarity. Examiner asserts that is it unclear whether the phrase “trim ring” and “finishing ring” are the same item. Applicant amended claim 1 to indicate that

“trim ring” and “finishing ring” are the same item, by referring to both as “finishing ring” for consistency (see page 7 of application, lines 21-22). Applicant further amended claim 7 for clarity and incorporate limitations of claim 7 into claim 1. No new matter is added nor intended by the Applicant for such amendments. Therefore, claims 1, 7, and 13 have been amended to particularly point and distinctly claim the invention.

The Examiner further states that he is unsure whether applicant is claiming just the accent frame or a combination of the accent frame and a recessed lighting fixture. The preamble of amended claim 1 is clearly directed to an “accent frame for framing an article inset within a cutout of a structure, said inset article including a *finishing* ring for providing a transition from said article to said structure.” Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim."). "[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). Here the preamble positively recites the finishing ring and then refers to it again in the body of the claim in connection with the accent frame. Since the preamble recites limitations in the claim, the

claim preamble should be construed as if in the balance of the claim. One skilled in the art would readily understand the scope of claim 1 and so claim 1 is definite. Claims 2-4, 6, 7 and 9-11, 13, and new claim 14 depend on claim 1 and thus the scope of the present invention is made clear in these claims as well.

The Examiner objected to claim 12 for an informality. Claim 12 has been canceled and the limitations have been incorporated into claim 1.

The Examiner rejected claims 1-5, 7, 9, 10, and 13 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,975,853 to Lackey (cover for a ceiling aperture). Lackey '853 discloses a ceiling aperture cover including a shell and back panel that attach together via posts and fasteners. The exterior of the shell has a hub which fits within an aperture in the interior of the shell, wherein the hub attaches to a mounting plate attached to a junction box connected to the ceiling. A light fixture or ceiling fan is attached to the mounting plate after a *circular cover is wedged between the junction box and mounting plate*. At the outset, it is important to note that the present invention simply *frames an article inset within a cutout of a structure*, utilizing only the finishing ring of the article to connect with the accent frame and cutout. There are a number of design features which distinguish Lackey '853 based on this goal. Claim 5 has been canceled and its limitations are incorporated into amended claim 1. Amended claim 1 requires an "accent frame for framing an article inset within a cutout of a structure, said inset article including a finishing ring" and said "accent frame comprising: a *rigid thin sheet of material* larger in size than the finishing ring" and "*said rigid thin sheet having an outer edge defining an object-shape and a convex inner edge defining an aperture having a lip for proper positioning with said cutout*, wherein said *cutout comprises slots* and said *finishing ring comprises expandable tension clips* for insertion through said aperture and said slots thereby *securing said frame in place*

between said finishing ring and about the cutout and against the structure". The "rigid sheet" with the "convex inner edge defining an aperture having a lip" and the "clips" of the "finishing ring" and corresponding "slots" in the "cutout" are all features that keep the "accent frame" secure over a "cutout" having an "inset article" therein (without require additional bulky blocks, screws, or other fasteners as in Lackey '853). These essential limitations of claim 1 are lacking from Lackey '853 and thus claim 1 and likewise depending claims 2-4, 6, 7 and 9-13 are patentably distinguished.

Furthermore, the essential limitation of "*rigid thin sheet having an outer edge defining an object-shape*" in claim 1 is absent from Lackey '853. The Examiner contends that the "decorative outer edge" of Lackey is "in the shape of a circular object". However, Lackey merely discloses a circular (geometric) shaped cover. *Merriam-Webster's Dictionary of Law* defines an object as "something material that may be perceived by the senses", and thus the geometric-shaped cover of Lackey '853 does not fit this definition. Claim 1 is patentably distinguished from Lackey '853 on this basis as well. Moreover, new claim 14 (dependent on claim 1) is added herein to further illustrate Applicant's meaning of said object-shape as including "a star, flower or house" (see page 8 of application, line 20). No new matter was added, nor was such the intent of the Applicant.

The Examiner rejected claim 6 under 35 U.S.C. 103(a) as being unpatentable over the Lackey '853 patent. As stated *supra*, amended claim 1 is patentably distinguished over the Lackey '853 patent. Likewise, depending claim 6 is patentably distinguished.

The Examiner rejected claim 11 under 35 U.S.C. 103(a) as being unpatentable over the Lackey '853 patent in view of U.S. Patent No. 6,152,413 to Gretz (integral electrical component mounting block). As stated *supra*, Lackey '853 fails to anticipate amended claim 1, and the '413

patent to Gretz does not bridge the gaps in claim language. Since claim 11 depends on claim 1, it is believed that claim 11 is likewise is patentably distinguished.

The Examiner rejected claim 12 under 35 U.S.C. 103(a) as being unpatentable over the Lackey '853 patent in view of U.S. Patent No. 6,474,846 to Kelmelis, et al. (flush trim collar lighting system). As stated *supra*, claim 12 has been canceled and the limitations have been incorporated into claim 1. Lackey '853 fails to anticipate amended claim 1, as stated *supra*, and the '846 patent to Kelmelis, et al. does not bridge the gaps in claim language. Therefore amended claim 1 is patentably distinguished over the combination of the Lackey '853 and Kelmelis, et al. '846 patents as well.

In view of the above, all pending claims 1-4, 6, 7, 9-11, 13, 14 are believed to avoid all the objections/rejections set forth in the Official Action and thus, the case should be in condition for allowance. A Notice to this effect is respectfully requested, and the Examiner is invited to call the undersigned at 410.347.7303 to discuss any remaining issues.

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Respectfully submitted,



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